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4 **E-FILED on** 11/19/09  
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8                               IN THE UNITED STATES DISTRICT COURT  
9                               FOR THE NORTHERN DISTRICT OF CALIFORNIA  
10                              SAN JOSE DIVISION  
11

12 THE CENTRAL INSTITUTE FOR  
13 EXPERIMENTAL ANIMALS, a Japanese  
14 corporation,

15                               Plaintiff,

16                               v.

17 THE JACKSON LABORATORY, a Maine  
18 corporation,

19                               Defendant.  
20

No. C-08-05568 RMW

ORDER DENYING DEFENDANT'S  
REQUEST TO FILE A MOTION FOR  
SUMMARY JUDGMENT

[Re Docket No. 70]

21               At the initial case management conference in this case, the court ordered that motions for  
22 summary judgment that turned solely on a dispute of claim construction should be briefed and  
23 argued concurrently with claim construction. The court set up a letter-briefing procedure to resolve  
24 disputes as to whether particular issues were appropriate for summary adjudication with claim  
25 construction.

26               Defendant The Jackson Laboratory ("Jackson") seeks permission to move for summary  
27 judgment that it does not infringe United States Patent No. 7,145,055 ("055 Patent") concurrently  
28 with claim construction. Jackson and plaintiff Central Institute for Experimental Animals ("CIEA")  
disagree as to whether Jackson will be legally entitled to summary judgment of non-infringement if

1 the court adopts Jackson's construction of "NOD/Shi mouse" and have filed letter briefs on the issue.

2 In the claim language at issue, "NOD" refers to the "non-obese diabetic" category of research  
3 mice originally developed in 1980 by Dr. Susumu Makino. Jackson Letter Brief 2 (Docket No. 70).  
4 Dr. Makino worked at Shionogi Research Laboratories at the time, and as a result his mouse colony  
5 took the name "NOD/Shi," where "Shi" is the "laboratory code" for Shionogi Research Laboratories.  
6 *Id.* Jackson argues that "[t]he inventors' choice of claim language means that the claims are limited  
7 to a process using mice from the NOD/Shi colony." *Id.* at 3. Specifically, Jackson contends that  
8 "NOD/Shi mouse" in the '055 Patent should be construed as: "A non-obese diabetic mouse from the  
9 original NOD mouse colony created by Dr. Susumu Makino at Shionogi Research Laboratories, or a  
10 mouse separated from that colony by less than 20 generations. NOD/Shi mice are commercially  
11 available from CLEA JAPAN, INC." Eppig Decl. ¶ 55 (Docket No. 65).


12 CIEA argues that the court should not adopt Jackson's proposed construction, contending that  
13 the 20-generation limitation is unwarranted. CIEA also argues that even if the court adopts  
14 Jackson's construction, a factual question will still remain as to whether Jackson's NOD/ShiLtSz  
15 mouse is a claimed NOD/Shi mouse and whether Jackson's NOD/LtSz mouse originates in part from  
16 the Shi colony. CIEA also says that it is entitled to prove that Jackson's mouse infringes the '055  
17 Patent under the doctrine of equivalents. Jackson responds that Jackson's mouse cannot infringe  
18 under the doctrine of equivalents as a matter of law because it is "disclosed-but-unclaimed" subject  
19 matter in the '055 Patent.

20 The court's requirement that summary judgment motions that turn solely on claim  
21 construction be heard contemporaneously with claim construction is, in part, to efficiently resolve  
22 those issues that do not require further development. The practice is designed to expedite and  
23 narrow the issues to facilitate early disposition of cases or at least particular claims. The court  
24 necessarily relies on the good faith of the parties in identifying the claim dispositive disputed claim  
25 terms, and, therefore, will generally accept a party's representation with respect to whether claim  
26 construction will be dispositive. If the court later finds that counsel's representation was not made in  
27 good faith, the court has remedies it can impose on the offending party such as the award of  
28 attorney's fees under 28 U.S.C. § 1927. Here, Jackson says that CIEA has no evidence to support its

1 claim that if Jackson's construction is adopted, there will still be a factual question of whether  
2 NOD/LtSz mice from Jackson are part of the NOD/Shi colony. The court accepts at this time  
3 CIEA's representation that it has a good faith basis for its argument. If it turns out that CIEA, in  
4 fact, has no such evidence, the court will take appropriate action. Jackson's argument that CIEA's  
5 doctrine of equivalents claim has no merit as a matter of law also raises issues, although perhaps  
6 only legal ones, in addition to claim construction. It appears that issues involving what CIEA  
7 previously disclosed and admitted may be contested.

8 The court, depending upon its construction, may schedule further summary judgment  
9 motions as the next step in the litigation, but it is not going to set Jackson's proposed motion to be  
10 heard concurrently with claim construction.

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12 DATED: 11/19/09

  
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RONALD M. WHYTE  
United States District Judge

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16 **Dated:** 11/19/09 CCL  
17 **Chambers of Judge Whyte**  
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